

## REMARKS

### INTRODUCTION

In accordance with the foregoing, the claim 9 has been amended, new claim 13 has been added, and claim 8 has been canceled, without prejudice or disclaimer. No new matter has been submitted.

It is understood that the Examiner has already amended previously filed claims 8-11 to be 9-12, with proper dependencies. Claims 9-12 are repeated above with this understanding.

Claims 9-13 are pending and under consideration.

### ENTRY OF THE THIS AFTER FINAL AMENDMENT

Entry of this Amendment Under 37 CFR 1.116 is respectfully requested. As noted below, the Examiner has already considered and interpreted the claimed write protection as requiring the exclusion of the PCA. Therefore, to clarify the record and place the claims in better condition for appeal, this feature has officially been added to independent claim 9. This feature has already been reviewed, considered, and searched, as evidenced by the Examiner's discussion of the same in the Office Action. Therefore, it is respectfully submitted that the addition of this feature to independent claim 9 does not raise any new issues or require an additional search.

In addition, as noted below, it is respectfully submitted that the outstanding rejection is based on a misunderstanding of the claimed features, i.e., claim 11 claiming BP2, and the support in the specification for the claimed exclusion of the RMA.

Further, it is respectfully submitted that the below comments more clearly explain the differentiation between the claimed invention and the cited references, as well as the non-obviousness of the proffered combinations.

Accordingly, with the outstanding rejections having been in error, it is respectfully requested that this Office Action be withdrawn, thereby permitting entry of new claim 13. It is further submitted that features of new claim 13 only further narrow the already allowable independent claim 9, with the Examiner having initially already searched and considered at least the claimed DVD-RW specification feature.

With these comments it is respectfully requested that the allowability of the pending claims be reconsidered. It is respectfully submitted that the claimed invention patentably distinguishes over the cited prior art.

## INFORMATION DISCLOSURE STATEMENTS

The outstanding Office Action indicates that the references cited in the November 16, 2003 IDS have been considered.

However, it is again noted that the Examiner still has not considered the IDS filed concurrently with the present application. The references cited there were included in the parent application, were not required to be included in the filing of corresponding IDS, and must be considered, as applicants have met every requirement for the same.

The Examiner is respectfully requested to request each related application, as necessary, to ensure that each IDS reference submitted in the present application is considered, noting again that all formal requirements have been met. Particularly, under 37 CFR § 1.98(d), when a continuation application is filed applicants are not required to submit copies of references previously submitted in the parent application. Further, upon the filing of an IDS, the Examiner is required to review the same. "Once the minimum requirements of 37 CFR §§ 1.97 and 1.98 are met, the examiner has an obligation to consider the information." MPEP § 609. "The Examiner will consider information which has been considered by the Office in a parent application when examining a...continuation...or divisional application." MPEP § 609. In addition, as a convenience, applicants have already provided the Examiner with copies, on December 4, 2002, of the related references, since the Examiner had indicated that the co-pending applications were not available.

Further, the Examiner has indicated that some co-pending applications have not been considered, even though consideration of the same has been particularly requested. Again, the Examiner is respectfully requested to request the files of each application, as necessary, to ensure that each co-pending application is considered.

## CLAIM OBJECTIONS

The Examiner has renumbered previously added claims 8-11 to 9-12, as there was already a pending claim 8 that had not previously been canceled. Claim 8 has been canceled in the outstanding amendment.

Claim 12 has been objected to for not further limiting the base claim, as it includes a "wherein" clause, and the Examiner has considered the same to not have any patentable weight.

Specifically, the Examiner has indicated that the "wherein" clause is interpreted as a function, process, or method, and therefore is not further limiting the medium claims.

This objection is similar to the previous § 112 rejection of then pending claim 4, where the then pending Office Action essentially stated that the product "recording medium" cannot include process steps or rely on the same.

Applicants respectfully disagree. A medium, "wherein writing data on the medium is prohibited when the write protection information is set to a write protection state," is by definition, thereby required to have some physical feature enabling that wherein clause. The physical feature thereby included in the medium, enabling that wherein clause, distinguishes the claimed invention over other media, as well as independent claim 9.

Similarly, the MPEP has a whole section directed toward pointing out that product by process claims are permissible. See MPEP 2173.05(p). This section of the MPEP states "[a] product-by-process claim, which is a product claim that defines the claimed product in terms of the process by which it is made, is proper.... A claim to a device, apparatus, manufacture, or composition of matter may contain a reference to the process in which it is intended to be used without being objectionable under 35 USC §112, second paragraph, so long as it is clear that the claim is directed to the product and not the process."

Thus, the wherein clause cannot be disregarded and the underling functional/process/method features must be considered. Therefore, claim 12 does further limit the medium of claim 9.

Withdrawal of this objection to claims 9-12 is respectfully submitted.

#### REJECTION UNDER 35 USC 112, FIRST PARAGRAPH

Claims 9-12 stand rejected under 35 USC § 112, first paragraph, as failing to comply with the written description requirement. In particular, the Office Action has indicated that the claimed "except for the RMA" is not sufficiently disclosed in the specification.

The Office Action recites: "[a]s filed, this invention (claims) is drawn to the description/specification with respect to figures 13-15. The appropriately disclosed write protect information is defined as (BP)3. This is a single byte in the '0' [field] of the RMD area, however, the disclosure states that such a control flag/signal/byte write protects [(BP)2] everything except for the PCA. Hence, there is [no] support for the newly introduced limitation with respect to 'RMA'"

First, it is noted that the presently claimed invention is not limited solely to FIGS. 13-15 and corresponding specification disclosure. As a whole, the specification and claims disclose

several embodiments directed to different aspects of the present invention, but are not limited thereto, or limited to maintain inventive features in one embodiment from another embodiment.

In embodiments of the present invention, the specification discusses performing write protection, with the medium indicating whether the medium is write protected. As an example, see paragraph [0031], for differing potential aspects of this write protection. In this example, in the embodiment discussed in paragraph [0031], a medium can be write protected, with an area of the medium storing the write protection information, being accessible and modifiable.

Thus, based on this inherency, according to the invention of independent claim 9, the RMA area inherently would be accessible.

The Office Action references paragraph [0070] which references the example of the disc being write protected, "except for the PCA, etc." This reference to the PCA is only an example. See paragraph [0071], which states "02b indicates that the entire disc except for a part of the disc (e.g., the PCA) is write protected." Again, since this write protection is modifiable (or releasable), the RMA would inherently be accessible.

Thus, write protection of the medium except for the RMA is clearly supported by the specification. In addition, the Office Action has noted that this term in the specification only refers to the PCA. Since the Examiner would appear to be requiring the same, this term has been added to independent claim 9.

Since the Examiner has already interpreted the claims as relating to this modifiable (or releasable) write protection mode, and interpreted this feature as requiring access to the PCA, it is respectfully submitted that this addition to claim 9 does not raise new issues and has already been considered in the outstanding Office Action, and underlying search. Independent claim 9 also notes that the PCA and RMA are in a reading information area.

Regarding dependent claim 10, the Office Action states that the specification only refers to the write protection information being stored in BP3, not the claimed BP2.

However, paragraph [0072] points out that "[a]lso, the byte position BP2 of RMD field 0 stores the disc status information, so that write protection information can be stored in the byte position BP2 of RMD field 0."

Also, see the original parent application, which was filed with claim 20 reciting: "[t]he recording medium of claim 18, wherein the write protection information is stored in one of byte positions BP2 and BP3 of RMD field 0, and information indicative of types of disc, indicating whether the disc satisfies the DVD-RW or DVD-R specifications, is stored in byte positions BP0

and BP1 of the RMD field 0." Thus applicants clearly possessed the claimed BP2 byte position storing the write protection information, upon filing of the present application.

Regardless, with the above recitation in the specification and this particular recitation in the original claims, there is sufficient disclosure to support for the use of BP2 for storage of the write protection information.

In addition, the Office Action points to FIG. 14, "which shows the (BP) 2 not only as prior art but also as disc status information and not write protection." Briefly, it is noted that regardless of what is conventionally known of the RMA byte positions, the presently claimed invention has particularly defined the use of byte position BP2 for write protection information, which has not been disclosed in the prior art, either in the background of the present application or through extensive searches by the Examiner.

The choice of the placement of the write protection information in a particular area of a medium is based on particular problems applicants encountered when engineering the claimed medium and implementing the claimed write protection information. In media utilized in some embodiments of the present invention, embodiments permit the medium to be utilized either within a cartridge or outside the cartridge. To ensure that a write protection state of the medium was maintained, applicants devised a drive level logical write protection information. Conventional methods implemented either a physical level, e.g., write protect holes on the cartridge, or file level logical protection, e.g., recording write protection information along with each file being protected or stored elsewhere but still corresponding to that file being protected.

With the implementation of the drive level logical write protection, applicants, again through experimentation and analysis, settled on the RMA area to store this write protection information. Thus, based on a particular problem, applicants derived a proper placement of write protection information to overcome that problem. As further claimed, applicants further chose byte position BP2, of field 0, of the RMD, of the RMA.

Thus, the claimed exception to the RMA for preventing overwriting or erasing is clearly supported in the specification. Further, based on the above, it is respectfully submitted that it is clear from the specification that applicants had possession of the claimed invention at the time of filing this application. Withdrawal of these rejections is respectfully requested.

## REJECTION UNDER 35 USC 112, SECOND PARAGRAPH

Claims 9-12 stand rejected under 35 USC § 112, second paragraph, as failing to set forth the subject matter of the present invention.

Specifically, the Office Action recites: "[a]s written, the claim attempts to control (write protect) the entire medium with the exception of the RMA. Hence is NOT WRITE PROTECTED.

If such is true, then the system WOULD PERMIT THE OVERWRITING/ERASING of this signal (because this is where the write protection signal is found) and hence, defeating the purpose of the disclosure."

However, it is respectfully submitted that the Examiner has misunderstood the claimed invention. As noted above, with a modifiable (or releasable) write protection, the medium can be set to prevent unwanted overwriting and erasing, while the medium can also be reset/modified to remove this write protection state, i.e., the write protection state is modifiable or write protection can be released.

By changing the write protection information in the RMA, the write protection state of a medium can be changed from a write protected state to a non-write protected state, for example, likewise, if the medium is not write protected, then the medium can be changed to the write protected state, also as an example. At least with the claimed RMA being accessible and modifiable, the write protection state can be modified and the write protection state of the medium changed.

Thus, it is respectfully submitted that this claim is clear and descriptive of the presently claimed invention, as well as being fully supported by the present application. Withdrawal of this rejection is respectfully requested.

## REJECTION UNDER 35 USC 103

Claim 9 stands rejected under 35 USC § 103 as being obvious over Kuroda et al., U.S. Patent No. 5,946,277, in view of Kono, 5,305,296, and Ugon, U.S. Patent No. 4,211,919. This rejection is respectfully traversed.

The Office Action references Kuroda et al. as disclosing the claimed RMA, since it references an RMD area. Similarly, without support, the Office Action concludes that the claimed PCA is inherently included within Kuroda et al.

Further, "with respect to the PCA the examiner concludes that such are well known in this environment as acknowledged by applicants/Kono in figure 9 depicts PCA prior to the lead-

in area as being part of the prior art in this environment."

Without acquiescing to the above comments, the obviousness argument regarding the addition of write protection to Kuroda et al. will now be rebutted.

The Office Action sets forth that "[w]ith respect to the desired ability of having write protection information stored, Ugon teaches the ability of having additional write protection code: see the description of the write protect at col. 4, lines 26-40... It would have been obvious to modify the above combined references, Kuroda et al. and Kona, or just Kuroda et al. with the additional teaching from Ugon, motivation is to reduce the overhead at the block level and relocate a write protection ability in a data management field level. This would provide for an increased data block allocated to store information (data) and still provide for the write protection ability."

The Office Action continues, "[f]urthermore, the placement of this information into the specified area noted in the claim is considered merely a relocation of this signal. The normal understanding of management area is that of an area to store/hold/designate information about the record medium indicative thereof. To place an indication of copy protect from one area to another is not considered patentable, i.e., the placement of information control signals into various location are well known: McFerrin et al. – at col. 9 lines 10 plus – placement of a write start signal at the appropriate location; Drews et al. with respect to the description of figure 5, or again Ro et al/Ueda et al. as stated in the previous Office Action."

First, the Examiner is respectfully requested to provide legal support for the conclusion that the relocation of a signal is not patentable. In addition, as in the present application, if the signal did not previously exist, then there cannot be a relocation of the corresponding signal.

Contrary to this arbitrary conclusion, there is substantial legal precedent supporting the opposite, i.e., that the primary concern is whether there is sufficient motivation for the modification in the record.

To set forth a prima facie §103 rejection, there must be some evidenced reason for modifying a reference. Specifically, there must be evidence, outside of the present application, which motivates, leads, or suggests to one of ordinary skill to modify a reference. In addition, an "obvious to try" rationale for combining two references is not valid motivation under 35 USC §103. In re Goodwin, 576 F.2d 375, 377, 198 USPQ 1, 3 (CCPA 1978); In re Antonie, 559 F.2d 618, 195 USPQ 6 (CCPA 1977); In re Tomlinson, 363 F.2d 928, 150 USPQ 623 (CCPA 1966).

Thus, regardless of whether "write protection information" was previously known, because a particular placement of write protection information has been claimed, an obviousness rejection must be based on particular motivation supporting the argument to modify the underlying reference to also store write protection information in a particular claimed area.

The Examiner has concluded that it would have been obvious to add write protection to Kuroda et al. The Examiner sets forth several observations, which are actually conclusions of the Examiner, without support in the record. The Examiner has stated that "the normal understanding of management area is that of an area to store/hold/designate information about the record medium indicative thereof." This is the Examiner's understanding and conclusion.

In different media there are many different management areas, within a particular medium there may be several different management areas, with each management area storing different management information for different aspects of the medium.

In addition, in a particular standardized medium specification, such as a DVD specification, including those that include the claimed RMA area, a decision to place particular information in particular areas is derived through extensive analysis and experimentation. For example, while a number of byte positions of the RMA are defined, as illustrated in FIGS. 13 and 14 of the present application, a number of them are not defined. Similarly, other management areas throughout the medium may include undefined areas.

In conventional write protection references, previously cited against claims of the present invention, write protection information was either at a physical level or file level, while the presently claimed RMA storing of write protection can be considered a drive level write protection. These differences are fundamental to understanding the potential motivation for modifying a reference to store write protection information in a particular area. As noted above, the presently claimed invention was implemented to solve a problem, with the placement of the write protection information in the particularly claimed area solving that problem.

Thus, the Office Action concludes that that a management area would be the logical place to store write protection information, and in this case the RMA, since the RMA stores management information about the medium. However, there are many areas of the medium that store information about the medium. See FIG. 11 of the present application, which illustrates the Lead-in area, and FIG. 12, which illustrates the Control Data Zone, both of which obviously include management information about the medium as a whole. Similarly, the presently claimed invention is directed toward write protection information for the whole medium. If the Examiner's



logic was appropriate, then it would have also been equally obvious to add the write protection information to the Lead-in area, or even the Control Data Zone. Without any reason to chose one area over there other, the Examiner can not just conclude that the claimed RMA area would have been an obvious choice.

As illustrated in FIG. 13, of the present application, the RMA includes defect management information, i.e., detailed information about particular areas of the medium and the defect management thereof. Thus, here, it would appear that the RMA includes more detailed information about particular areas of the medium, while the claimed write protection information is directed toward a more general write protection of the whole medium.

Regardless, assuming there is motivation to add write protection information, there are multiple places to place write protection in a medium. It is respectfully submitted that the RMA area is not the logical conclusion for storing the write protection information. Further, in view of the fact that the placement of write protection information has not been standardized, as of the filing of the application, it is respectfully submitted that this is further evidence against the obviousness of placing the write protection information in the RMA. If it were so obvious, then it is respectfully submitted the previous standardization of the medium illustrated in FIG. 10, of the present application, would have already defined the write protection information as being in the RMA. However, this is not the case. Only the applicants have particularly chosen the claimed RMA, for a particular reason to solve an inventor identified problem, as the place to record write protection information for preventing erasing and/or overwriting of information for the whole medium.

To support the obviousness of the modification of Kuroda et al., the Examiner cited several previously cited references, noting the placement of "information control signals" into various locations. Inherently, each underlying system has to store their respective "information control signals" somewhere on the respective storage media. The difference between the presently claimed invention, as well as the differences between each reference, is that each reference and the presently claimed invention has set forth a particular placement for the particular "information control signal." In each case there are underlying rationales for each placement; each system and media are different, having different needs, resulting in different problems, and different solutions.

None of the cited references sets forth the need or suggestion to store the claimed write protection information in the RMA field. Further, none of the references have disclosed or suggested the aforementioned problem solved by the placement of the write protection

information in the RMA.

Further, the Office Action's citations of the other references actually supports the non-obviousness of the presently claimed write protection information in the RMA field.

As each reference stored different information in different fields, for different reasons, it can be derived that the placement of the claimed write protection information in a particular field of a medium must be based on some underlying knowledge of the corresponding medium and the corresponding problems with placing the write protection information in differing areas, as well as the benefits of one area over the other. In each cited reference, the corresponding medium is discussed and the benefit of the particularly chosen area to store the particular information is particularly discussed. Again, each reference supports the argument that each system is different and the underlying reasons for placing particular information in different areas of the media is individual to that media.

Thus, it is respectfully submitted that the recited generality that it would have been obvious to place the write protection information in a management area is not supported by the record. Each system is different.

Lastly, it is noted that the Office Action has recited that it would have been obvious to add the write protection of Ugon to Kuroda et al. "to reduce the overhead at the block level and relocate a write protection ability in a data management field level. This would provide for an increased data block allocated to store information (data) and still provide for the write protection ability."

Ugon would appear to merely set forth a banking memory card with a particular two bit locking scheme for different parts of the banking memory card. For particular memory areas to be accessible, a predetermined memory area having the two bit lock, has to be set to "11," for example. Thus, again, Ugon only discloses the use of some type of write protection. Like the above references, the placement of the write protection information is very particular to the underlying memory card and underlying data structure in Ugon.

The Office Action would appear to be relying on Ugon only because Ugon discloses byte level write protection information.

However, the system of Ugon is for the particular bank card memory allocation, i.e., having particular memory elements stored in a particular arrangement for the operating of the underlying system.

The two systems, Ugon and Kuroda et al. would appear to be completely unrelated,

except for them both being some type of storage device. Other than this vague connection, there would not appear to be any reason for one skilled in the art to look to Ugon to support the conclusion to add write protection to Kuroda et al. In addition, as the underlying memory device is fundamentally different from the storage medium in Kuroda et al., it is unclear how one skilled in the art would derive from Ugon the need in the medium of Kuroda et al. for similar write protection. The write protection in Ugon appears to be related to the banking field for protection of underlying information. Such banking problems and needs would not appear directly applicable to the medium in Kuroda et al. Thus, it is not clear in the record how the banking card data format of Ugon would teach one skilled in the art to implement write protection in the DVD of Kuroda et al.

Further, the Office Action has indicated that the rationale for modifying Kuroda et al. to incorporate the write protection system of Ugon is to "reduce the overhead at the block level and relocate a write protection ability in a data management field level."

However, it is not clear how Kuroda et al. would suffer from the "overhead at the block level" or need to relocate "a write protection ability in a data management field level." First, there needs to be a rationale or need for the purported write protection in Kuroda et al. Secondly, the Office Action has merely cited benefits from the system of Ugon and merely concluded the same would apply to Kuroda et al. Again, there is no support that Kuroda et al. has an overhead at the block level, in need of being reduced, or that the addition of the Ugon system would solve the same. Further, the Office Action would appear to be adding the write protection from Ugon to Kuroda et al., and then making the argument that Kuroda et al. would need a benefit of Ugon to place that write protection information in a particular place in Kuroda et al., i.e., Ugon cannot be used as support for solving a problem in Kuroda et al. deriving from the addition of the write protection information of Ugon to Kuroda et al., when there is no underlying evidenced motivation for the initial write protection addition.

The Office Action also sets forth that the addition of the write protection system of Ugon to Kuroda et al. would "provide for an increased data block allocated to store information (data) and still provide for the write protection ability."

Again, it is not clear how the application of the system of Ugon would achieve these benefits. The Examiner would appear to be merely concluding that such benefits would be achieved, without any support in the record. As the two systems are so fundamentally different, it is both unclear how the system of Ugon would be incorporated into Kuroda et al. or what ultimate benefits or drawbacks would derive therefrom.

Further, the record is vacant of support that Kuroda et al. suffers from these ailments.

The Examiner is attempting to force the two references together, where there would not appear to be any reason for their combination. Further, the underlying motivation and arguments for combination are unsupported by the record and are only the opinion of the Examiner. Which is insufficient to uphold a prima facie obviousness case.

Thus, as detailed above, it is respectfully submitted that it would not have been obvious to modify Kuroda et al., in view of Ugon, as well as the Examiner's management area logic opinions, to disclose the presently claimed invention.

As noted above, each underlying system is different, with each system having different problems and needs. In each system, through a number of variables, the ultimate placement of information fields is finally decided upon. As noted, there are a number of these variables. In addition, in each medium, there are a number of management areas. The claimed RMA area has been chosen by the inventors, through experimentation and analysis, and nothing in the record provides support for placement of write protection information in the same. Thus, merely because the RMA area is available in the medium of Kuroda et al. does not automatically mean that it would have been obvious add the claimed write protection thereto.

Through the development of media, there are inherently a number of different features needed or desired in media, with write protection information being only one. With the Examiner's rationale, it would have been obvious to add each and every media-wide applicable feature to the RMA, noting that the RMA's size is not unlimited.

Further, it is respectfully submitted that the cited motivation for modifying Kuroda et al. is insufficient to uphold a prima facie obviousness case. The two systems are fundamentally different, and the record fails to support the Examiner's conclusions of either the need or desire to add the write protection system of Ugon to Kuroda et al. or the ultimate benefit of such an addition.

Therefore, for at least the above, it is respectfully requested that this rejection be withdrawn.

Claims 10 and 11 stand rejected under 35 USC § 103 as being obvious over Kuroda et al. and Ugon, in view of Heo, U.S. Patent No. 6,392,969, or Maeda et al., U.S. Patent no. 6,072,759. This rejection is respectfully traversed.

As the Examiner has misinterpreted the claim language, it is respectfully submitted that this rejection is improper. Regardless, the following is noted.

The Office Action recites: "The particular bit location, bp 3, bp0, etc. as found in this claim is considered to be obvious over the DVD formats of either Heo or Maeda et al. - both of which indicate such nomenclature is known when identifying sections of the dvd formats, see figures 8b, 9d, 16, 17b, 18b and c in Heo which uses such bit designation for a plurality of uses - note in particular the use for designating attributes of the information....Placing of control information at the particular bit positions is considered merely design expediency as long as such does not conflict with previously used bit positions."

Here, the Examiner has replaced the motivational requirements with his own conclusions of what would have been obvious, based on a design choice, which is incorrect, as noted above. In addition, regardless what "nomenclature" used, the Examiner is also required to present a prima facie obviousness case of why one skilled in the art would have made the proffered modifications or found such modifications obvious.

As the inventors have chosen the particular BP2, any obviousness rejection must address this feature.

Any prima facie obviousness case must particularly point out why one skilled in the art would have chosen the particular field of the RMD and byte position BP2, as claimed. Further, the obviousness cannot be derived solely from the Examiner's opinion of what would have been obvious. The record must support the obviousness. Choosing of particular byte positions in other references is completely unrelated to the presently claimed invention. Inherently, each system that defines fields will define fields to a byte position, at some point. That fact does not automatically make any particular choice of a byte position in the RMA field obvious.

In addition, the fact that the Examiner has particularly misunderstood the fact that applicant is particularly claiming BP2 over BP3 is further evidence of the non-obviousness of this claimed feature. As noted by the Examiner, BP2 is already defined. Since BP2 is already defined, the Examiner presumed applicant meant BP3, which is open. Choosing an already defined byte position would not have been obvious.

Therefore, it is respectfully submitted that the Office Action has failed to present a prima

facie obviousness case for the rejection of claims 10 and 11.

Claim 12 stands rejected under 35 USC § 103 as being obvious over Kuroda et al. and Ugon based on Official Notice. This rejection is respectfully traversed.

For at least the allowability of the independent claim 9, it is respectfully submitted that claim 12 is also in proper condition for allowance.

#### CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

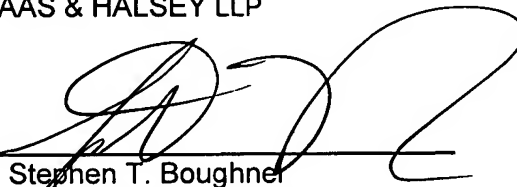
Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 8/18/04

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